Remarks

Claims 1 to 21 are pending in the present application. Claims 1-4, 10-13, and 19-21 have been amended. No new matter has been added. Claim 21 stands rejected under 35 U.S.C. § 112 as indefinite. Claims 1, 3, 10 and 12 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 5,848,396 to Gerace (hereinafter "Gerace"). Claims 2, 5-7, 9, 11, 14-16 and 18-20 stand rejected under 35 U.S.C. § 103 as unpatentable over Gerace in view of webpages from Broadcast.com (hereinafter the "Broadcast.com reference"). Claims 4 and 13 stand rejected under 35 U.S.C. § 103 as unpatentable over Gerace. Claims 8, 17 and 21 also stand rejected under 35 U.S.C. § 103 as unpatentable over Gerace in view of the Broadcast.com reference. These rejections are respectfully traversed by the following remarks. Reconsideration of the present application is requested.

The rejection under 35 U.S.C. § 112 should be withdrawn.

Claim 21 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 21 has been amended to, inter alia, depend from claim 20 instead of claim 19. Accordingly, the rejection of claim 21 under 35 U.S.C. § 112, second paragraph, has been addressed, and should now be withdrawn.

The rejections under 25 U.S.C. §§ 102 and 103 should be withdrawn.

In order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose each and every element of the claim in exactly the same way. *See Lindeman Machinenfabrik v. Am. Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984); MPEP § 2131.

In order to reject a claim for obviousness under 35 U.S.C. § 103, the prior art must teach or suggest each and every element of the claim and must also suggest combining the elements in the manner contemplated in the claim. *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), *cert. denied* 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990).

Applicant respectfully submits that this criteria is not met here.

Claim 1 of the present application recites:

>A method of responding to a request, the method comprising the steps of:
>>establishing a plurality of categories of potential

requests;
associating a plurality of sets of data with each of the
categories; and,
in response to receipt of a request, assigning the request
to one of the categories based on a subject matter in the data
requested, relating one of the categories to the request
according to the assignment, and preparing a response
including at least two sets of data from the related category,
said response including at least the data requested by the
request.

Gerace describes a system for providing advertisements to an Internet user by
developing a behavioral profile of the user based on the user's previous selections and
viewing habits (Col. 4:11-23). The system then selects and displays ads to this user based on
the created user profile, i.e., the information previously tracked and recorded (Col. 4:29-35).

In contrast to the user profile approach of Gerace, claim 1 recites a method where a
response to a request is prepared based on assigning and relating the request to a category of
requests *based on the subject matter in the data requested*. Gerace, however, describes
delivering ads *based on a profile of past user behavior*, not based on the subject matter in the
current requested data.

Claim 3 of the present application recites:

A method of responding to a request, the method comprising
the steps of:
establishing a plurality of categories of potential
requests;
associating a plurality of sets of data with each of the
categories;
archiving successive requests from a given requester;
and,
in response to receipt of a new request from the same
requester, assigning the new request to one of the categories
based on a subject matter in the data requested, relating one of
the categories to an archived request and the same or a different
category to the new request according to the assignment of the
new request, and preparing a response including at least two
sets of data from at least one related category or at least one set
of data from each of at least two related categories.

Claim 3 recites a method where a response to a request is prepared based on assigning
and relating the request to a category of *requests based on the subject matter in the data
requested*. Thus, claim 3 is allowable over the Gerace because Gerace describes delivering
ads based on only a profile of past user behavior and does not consider the subject matter in

the current requested data.

Claim 5 of the present application recites:

> A method for providing user information related to a user's selection of audio data, the method comprising the steps of:
>> receiving a user's selection of audio data and an indicium identifying the user;
>> analyzing the user's present selection of audio data and previous selections, if any, of audio data, and identifying at least one user interest category based on the user's present and previous audio data selections;
>> selecting at least one user information item from the at least one identified user interest category;
>> associating or combining the at least one user information item with the user's audio data selection; and
>> delivering the associated or combined at least one user information item and the user's audio data selection to the user over an electronic network.

Claim 5 recites a method where an information item related to the user's selection of audio data is provided to a user based on analyzing the user's present selection and any previous selections to identify at least one user interest category, selecting an information from at least one of the identified categories and delivering that information item with the user's audio data selection to the user. Thus, claim 5 is allowable over the Gerace because Gerace describes delivering ads based on only a profile of past user behavior, not based on the user's current selection of data. The Broadcast.com reference does not cure this deficiency of Gerace and the Examiner does not assert that it does. Thus, claim 5 is allowable over the combination of Gerace and the Broadcast.com reference.

Claim 10 of the present application recites:

> A system for responding to a request, the system comprising:
>> a store for data organized in a plurality of categories each including a plurality of sets of data; and
>> means responsive to receipt of a request for assigning the request to one of the categories based on a subject matter in the data requested, relating one of the categories to the request and preparing a response including at least two sets of data from the related category, said response including at least the data requested by the request.

In contrast to the user profile approach of Gerace, claim 10 recites a system where a response to a request is prepared based on assigning and relating the request to a category of requests *based on the subject matter in the data requested*. Thus, claim 10 is allowable over

the Gerace because Gerace describes delivering ads based on a profile of past user behavior, not based on the subject matter in the current requested data.

Claim 12 of the present application recites:

> A system for responding to a request, the system comprising:
> a store for data organized in a plurality of categories each including a plurality of sets of data;
> means for archiving successive requests from a given requester; and
> means responsive to receipt of a new request from the same requester for assigning the new request to one of the categories based on a subject matter in the data requested, relating one of the categories to an archived request and the same or a different category to the new request according to the assignment of the new request, and preparing a response including at least two sets of data from at least one related category or at least one set of data from each of at least two related categories.

Claim 12 recites a system where a response to a request is prepared based on assigning and relating the request to a category of *requests based on the subject matter in the data requested*. Thus, claim 12 is allowable over the Gerace because Gerace describes delivering ads based on only a profile of past user behavior and does not consider the subject matter of the current requested data.

Claim 14 of the present application recites:

> A system for providing user information related to a user's selection of audio data, the system comprising:
> an audio data server that receives a user's selection of audio data and an indicium identifying the user;
> a user information server that analyzes the user's present selection of audio data and
> previous selections, if any, of audio data, that identifies at least one user interest category based on the user's present and previous audio data selections that selects at least one user information item from the at least one identified user interest category, and that associates or combines the at least one user information item with the user's audio data selection; and
> an audio data delivery system that delivers the associated or combined at least one user information item and the user's audio data selection to the user over an electronic network.

Claim 14 recites a system where an information item related to the user's selection of audio data is provided to a user based on analyzing the user's present selection and any

previous selections to identify at least one user interest category, selecting an information item from at least one of the identified categories and delivering that information item with the user's audio data selection to the user. Thus, claim 14 is allowable over the Gerace because Gerace describes delivering ads based on only a profile of past user behavior, not based on the user's current selection of data. The Broadcast.com reference does not cure this deficiency of Gerace and the Examiner does not assert that it does. Thus, claim 14 is allowable over the combination of Gerace and the Broadcast.com reference.

Claims 2, 4, 6 to 9, 11, 13, and 15 to 21 are dependent on claims 1, 3, 5, 10, 12 or 14, thus they are allowable for at least the reasons that claims 1, 3, 5, 10, 12 and 14 are allowable.

Thus, it is respectfully submitted that the rejection of claims 1 to 21 under 35 U.S.C. §§ 102(b) or 103 should be withdrawn.

Conclusion

It is respectfully submitted that the application is in condition for allowance, and Applicant requests reconsideration and withdrawal of all grounds of rejection.
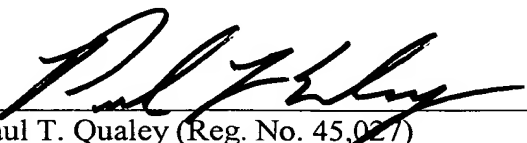
A Notice of Allowance is respectfully requested.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §§ 1.16 or 1.17 to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at (212) 425-7200 to discuss the application.

Respectfully submitted,

Dated: 3/31/04

By: _____
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